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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/440,106	11/15/1999	CHARLES S. TAYLOR	GUID-003DIV2	2546

36154 7590 05/30/2003

LAW OFFICE OF ALAN W. CANNON  
834 SOUTH WOLFE ROAD  
SUNNYVALE, CA 94086

EXAMINER

NASSER, ROBERT L

ART UNIT	PAPER NUMBER
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3736

DATE MAILED: 05/30/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/440,106

Applicant(s)

TAYLOR, CHARLES S.

Examiner

Robert L. Nasser

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 30 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 2,3,7-9,12,17-24 and 31-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 17-22 and 41-43 is/are allowed.
- 6) ☐ Claim(s) 2,3,7,12,23,24,32-34,37-40 and 44 is/are rejected.
- 7) ☐ Claim(s) 8,9,31,35 and 36 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

The examiner notes that upon further review, the examiner misinterpreted the Wright et al reference and now concludes that it is not dome shaped. As such, the finality of the previous rejection is withdrawn and the following rejection entered.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 12, 14, 24, and 37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 12 and 14 are rejected in that they depend on claim 11, which was canceled. It appears that these claims should depend on claim 24. Claims 24 and 37 are rejected as being duplicates of each other. Clarification is required.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 12, 14, 24 and 37 are rejected under 35 U.S.C. 102(e) as being anticipated by Vierra et al. Vierra shows a device having first and second shafts 25

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(the proximal end of element 17), which are joined by an articulating link 41 and/or 51.

The shafts terminated in blocks 15 and 17, having ports 73 therein which can be connected to a source of suction for aspirating fluids away from the site of application.

Claim 44 is rejected under 35 U.S.C. 102(b) as being anticipated by Palmer et al. Palmer et al shows a vacuum wand having the identical structure as the claim. The examiner notes that the language defining the use of the device on the heart is intended use and is not sufficient to define over the identical structure in the references.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 3, 7, and 23 are rejected under 35 U.S.C. 103(a) as being obvious over Palmer et al in view of Nishiguchi et al. Palmer shows a vacuum wand comprising a housing having internal and external walls, where the external walls converge towards each other, with an exterior ring for contacting a semiconductor wafer, and a single, central suction port connect to a suction line to cause the wafer to be forced against the wand. The claims recite a plurality of suction ports. Nishiguchi et al shows an alternate vacuum pickup device that has a plurality of suction ports emanating from a suction space in the housing between the walls, to reduce the stress on any one area of the wafer being picked up. As such, it would have been obvious to modify Palmer to use multiple suction ports, like in Nishiguchi, to prevent damage to the wafer. The examiner

notes that the language defining the use of the device on the heart is intended use and is not sufficient to define over the identical structure in the references.

Claims 33-35 are rejected under 35 U.S.C. 103(a) as being obvious over Vierra et al in view of Slater and Borst et al. Vierra et al shows all of the features of claims 33-35, except that the feet are not interlinked by a pivot, but rather by two pivots, and that the feet 15 and 17 frictionally engage the heart surface, rather than engage the heart surface by using suction. The examiner notes, that, as discussed above, Vierra has two shafts and two pivots. Slater is selected from a myriad references that show two elements that operate in a scissor-like relationship connected by a single pivot. Hence, it would have been obvious to modify Vierra et al to use a single pivot, as it is merely the substitution of one known equivalent connection for another. In addition, Borst teaches that suction is an alternate way for such a foot to engage the heart. Hence, it would have been obvious to modify the above combination to use suction as the engaging force, as it is merely the substitution of one known engaging means for another.

Claims 38-40 are rejected under 35 U.S.C. 103(a) as being obvious over Vierra et al in view of Borst et al.

Claims 17-22 and 41-43 are allowable.

Claims 8, 9, 31, 35, and 36 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ohnaka shows a dome shaped vacuum pickup device.

Weigand shows a device with a dome shaped housing having a single suction port in a bottom ring.

Nagai et al and Priest et al show vacuum pickup devices that have similar structure to the claims.

Mammel shows a pickup device that uses the Bernoulli effect rather than suction.

Applicant's arguments filed 1/30/2003 have been fully considered but they are not persuasive.

Applicant argued with respect to claims 32-34 and 37-40 that Vierra only has one shaft and two feet. However, as discussed above, it is the examiner's position that Vierra has two shafts and two feet.

The remaining arguments are deemed moot in view of the new grounds of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert L. Nasser Jr. whose telephone number is (703) 308-3251. The examiner can normally be reached on Monday-Thursday and alternate Fridays from 8:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg, can be reached on (703) 308-3130. The fax phone number for this Group is (703) 308-0758.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [max.hindenburg@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122.

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This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0858.

RLN

May 24, 2003

*Robert L. Nasser*  
ROBERT L. NASSER  
PRIMARY EXAMINER